

REMARKS

Favorable reconsideration and allowance of the Claims of the present application are respectfully requested.

Applicants have carefully considered the Official Action mailed on August 6, 2009. Of the pending claims, the Official Action has objected to Claims 24 and 25 as allegedly being in improper dependent form.

The Official Action has rejected Claims 23-31 under 35 U.S.C. §112 second paragraph as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Official Action also rejects Claims 26-31 under 35 U.S.C. §112 first paragraph as allegedly failing to comply with the written description requirement.

The Official Action has further rejected Claims 18 and 21 -31 under 35 U.S.C. §102(b) as allegedly anticipated by GenBank accession number AA10156 (hereinafter, "the GenBank reference"). The Official Action has also rejected Claims 18 and 21-31 under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent No. 7,166,703 to Goddard et al. (hereinafter, "Goddard"). Claims 24 and 25 have been amended to depend on Claims 21 and 22 respectively.

Claims 18 and 22 have been amended to recite a DNA oligomer capable of hybridizing in full-length under high stringency conditions to the full length of a nucleic acid molecule. Support for this amendment can be found throughout the application, such as at page 21 line 7 to page 22 line 2 and page 29 line 29 to page 30 line 7.

Claims 23-25 are amended to recite the group consisting of SEQ ID NO: 1, and nucleotides 97-912 of SEQ ID NO: 1. Support for this amendment can be found in original

Claim 18 and throughout the application, such as at page 29 lines 12-28. No new matter has been added into the disclosure by way of these amendments.

Claims 26-31 are canceled.

In view of the following remarks, Applicants request further examination and reconsideration of the present patent application.

Claim Objections

Claims 24 and 25 are objected to as being in improper dependent form. Claims 24 and 25 have been amended to depend on Claims 21 and 22 respectively. Thus the objection to Claims 24 and 35 is overcome. Withdrawal of the objection and issuance of Claims 24 and 25 is earnestly solicited.

Rejections under 35 U.S.C. §112

Claims 23-31 stand rejected under 35 U.S.C. §112 second paragraph as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Claims 23-25 are amended to recite the group consisting of SEQ ID NO: 1, and nucleotides 97-912 of SEQ ID NO: 1. This group recitation distinctly claims the subject matter which Applicants regard as the invention. Further, Claims 26-31 are canceled.

Thus, the rejection of Claims 23-31 under 35 U.S.C. §112 second paragraph is overcome. Withdrawal of the rejection and issuance of Claims 23-25 is earnestly solicited.

Claims 26-31 stand rejected under 35 U.S.C. §112 first paragraph as allegedly failing to comply with the written description requirement.

Claims 26-31 are canceled. Thus, the rejection of Claims 26-31 under 35 U.S.C. §112 first paragraph is overcome.

Rejections under 35 U.S.C. §102

Claims 18 and 21 -31 stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by the GenBank reference. Claims 18 and 22 have been amended to recite a DNA oligomer capable of hybridizing in full-length under high stringency conditions to the full length of a nucleic acid molecule.

The GenBank reference discloses one specific, structurally definable compound containing 415 base pairs. Page 5 of the Official Action admits that SEQ ID NO:1 is only 74.5% identical to SEQ ID NO:2, which is 99.2% identical to the molecule in the GenBank reference. The GenBank reference does not disclose or teach a DNA oligomer capable of hybridizing in full length to the full length of nucleic acid molecules recited in Claims 18, 21, 22 and all claims depending therefrom of the present application.

Thus, the GenBank reference is not an anticipatory reference, because it lacks a disclosure of a DNA oligomer capable of hybridizing in full length to the full length of nucleic acid molecules recited in Claims 18, 21, 22 and all claims depending therefrom of the present application. Withdrawal of the rejection and issuance of 18 and 21-25 is earnestly solicited.

Claims 18 and 21-31 stand rejected under 35 U.S.C. §102(e) as allegedly anticipated by Goddard.

The present application is a continuation of Application No. 09/397,243 filed on September 16, 1999. Application No. 09/397,243 is the non-provisional application of provisional Application No. 60/100,638, filed September 16, 1998. The priority date of the present application is September 16, 1998 based on the filing of provisional Application No. 60/100,638. The earliest possible priority date that could be afforded to Goddard is October 7, 1998 based on the disclosure in Provisional Application No. 60/103,328. Thus, the present

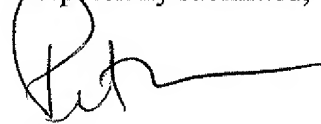
application appears to predate Goddard. Goddard, therefore is not a proper prior art reference.

Thus, Goddard is not an anticipatory because it is not a proper prior art reference.

Withdrawal of the rejection and issuance of 18 and 21-25 is earnestly solicited.

For the reasons set out above, Applicants respectfully submit that the application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are respectfully requested. Should the Examiner believe that anything further is needed to place the application in even better condition for allowance, the Examiner is requested to contact the Applicants undersigned representative at the telephone number below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Peter I. Bernstein', with a long horizontal flourish extending to the right.

Peter I. Bernstein
Registration No. 43,497

Scully, Scott, Murphy, & Presser, P.C.
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343
PIB/DRB:vh/dk